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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/779,044	01/06/97	THOMMES	J ITW-7188A

EXAMINER

GEORGE R CORRIGAN
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IM41/0526

SHAW, C	
ART UNIT	PAPER NUMBER

1742

DATE MAILED: 05/26/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 4/2/1998

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-12 & 14-24 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-12 & 14-24 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

DETAILED ACTION

1.) The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide a description of the power factor correction aspect of applicant's invention so as to enable an artisan of ordinary skill to make and use the invention. All of the independent claims call for some form of power factor correction. Applicant points to page 11, line 32 of the specification for the disclosure of the power factor correction technique used in his invention. Examiner can find no other mention of power factor correction in the specification. In its entirety, the power factor correction disclosure on page 11 reads "A Unitrode power factor correction chip is used to implement boost circuit 102 in the preferred embodiment and requires average current flow as an input." This disclosure is inadequate for several reasons. First, it is not clear exactly what a "Unitrode power factor correction chip" is (if "Unitrode" is a trademark it should be so indicated). Second, it is not clear where in the circuit shown as element 102 in figure 3 a power factor correction chip would be placed. Circuit 102 is a dc to dc converter and it is not clear from the description of its operation as set forth in the specification how a power factor correction chip could be incorporated into the same. Alternatively, it is not clear how circuit 102 could be "implemented" by a power factor correction chip. Thirdly, and on a more fundamental level, it is not at all clear how "power factor" correction could be

incorporated into a d.c. to d.c. converter such as that of element 102. Power factor is a phenomena associated with alternating current circuits. It is unclear how circuit 102, which apparently is an exclusively direct current circuit, could incorporate or benefit from power factor correction. In regard to the relationship between the disclosed invention and the claimed invention, claim 9 specifies that a first a.c. signal is power factor corrected, but the disclosure indicates that power factor correction takes place after the first a.c. signal is rectified into a d.c. signal. It is thus not clear how claim 9 corresponds to the invention described in the disclosure. Claim 17 specifies that a d.c. signal is power factor corrected. It is not clear how a d.c. signal can be power factor corrected. Also, it is not clear how claim 9 can refer to power factor correcting an a.c. signal and claim 17 can refer to power factor correcting a d.c. signal when both claims refer back to a single disclosed invention. Because applicant's specification does not adequately set forth how power factor correction is implemented in the welding power supply disclosed, the specification would not enable an artisan of ordinary skill to make and use the invention.

2.) Claims 1-12 and 14-24 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

3.) Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 14, there is no antecedent basis for "the third a.c. signal". In claim 1, line 18, there is no antecedent basis for "the inverter".

The other claims are inadequate under the second paragraph of 35USC112 in that they depend from an inadequate claim.

4.) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP section 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ex. Clifford C. Shaw whose telephone number is (703)-308-1712.

C. SHAW/ccs
(703)-308-1712
5/21/98



Clifford C. Shaw
Primary Examiner
Art Unit 1742